Remarks

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of May 1, 2007. In the Office Action, claims 1-11 and 32-37 are pending with claim 1 being an independent claim. By this amendment, Applicant has amended claims 1, 10 and 32. Applicant believes that all of the amendments do not introduce new matter. Review and reconsideration of the claims are respectfully requested.

Claims 1-11 and 32-37 remain in this application and are believed to be in proper condition for allowance.

A. Claim Rejections under 35 U.S.C. §112

The Examiner rejected claims 10 and 32-37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner found it unclear how a host can "be" a configuration utility as described in claims 10 and 32.

In response, Applicant has amended claims 10 and 32 to clarify that the host is not a configuration utility but rather "includes" a configuration utility such that a configuration utility is part of a host. Claims 33-37 are dependent claims that depend either directly or indirectly from dependent claim 32. Therefore, Applicant respectfully asserts that amended claims 10 and 32, as well as claims 33-37, are in proper condition for allowance and requests that the Examiner withdraw his rejection.

B. Claim Rejections under 35 U.S.C. §103(a)

1. The Cited Art

The Examiner relied on two prior art documents in his rejection of claims 1-3, 7-11, and 32-37 under 35 U.S.C. 103(a): U.S. patent application 2003/000084132 to Ohta (Ohta) and U.S. patent application 2001/0039590 to Furukawa, et al. (Furukawa).

Ohta discloses a method of installing a printer driver on a computer for a networked printer. For a computer to communicate with a networked printer, the network address of the printer must be known and a suitable device driver must first be installed on the computer. Ohta facilitates this process by allowing a computer to open a virtual printer, providing access to connected peripheral printers on the network, at a consistent location on a server. See Ohta, S701 opening virtual printer, FIG. 7, and paragraph [0059]. The virtual printer then (i) downloads to the computer the necessary configuration information regarding the selected network printer, as well as, a suitable device driver for the computer to communicate properly with that selected network printer, and (ii) triggers the operating system of the computer to automatically install the printer driver using the configuration information. See Ohta, S702-S705, FIG. 7, and paragraph [0059-0074].

Therefore, in Ohta a computer communicates with a server via a virtual printer application to automatically configure a printer driver *on the computer itself* for accessing a networked printer, which is a type of network peripheral. However, Ohta does not teach, disclose, or fairly suggest a host computer that automatically configures a networked printer or peripheral itself as set forth in Applicant's claims. See Application, claim 1, "method of configuring a peripheral device...". Moreover, the device driver necessary to configure a

computer in Ohta to use a peripheral, such as a network printer, would not be used to configure the peripheral itself.

Also, Ohta requires a user to select on a computer screen a desired network printer from the virtual printer program, and only then is the appropriate printer driver automatically installed. See Ohta, FIG. 15, and paragraph [0093]. Ohta therefore requires some user intervention in the selection of the desired printer, whereas Applicant specifically claims no user intervention. See Application, claim 1. And finally, Ohta concerns communications between a client and a server regarding a peripheral device, and not direct communications between a host computer and a peripheral device as in Applicant's disclosure.

Ohta is therefore directed towards a different invention than Applicant's disclosure. Specifically, Ohta discloses configuring a computer to use a peripheral device wherein Applicant claims a method for configuring the peripheral device; Ohta requires user interaction in direct contravention to the specific element of "no user intervention" in Applicant's independent claims; and Ohta requires direct communication only between a client and a server as opposed to Applicant's method of communication between a host computer and a peripheral device. Therefore, it is readily apparent that Ohta differs structurally and functionally from the various embodiments of Applicant's disclosure.

Regarding Furukawa, Furukawa discloses a method of configuring an IP address on a remote device that has been preconfigured with a multicast address. Based upon the disclosed inventions of Ohta and Furukawa, one of ordinary skill in the art would not combine Ohta with Furukawa because Ohta discloses a method of configuring a computer to use a printer, whereas Furukawa discloses an unrelated method of configuring a remote printer with an IP address.

2. Claim 1 Rejection

The Examiner rejected claim 1 under under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Furukawa. In particular, the Examiner states that Ohta teaches a method of using a server to configure a peripheral device on a network to communicate with a host computer, but does not explicitly disclose the source of a response to the host computer directed to the current configuration information of a peripheral. The Examiner continues by relying on Furukawa as teaching a host computer receiving a response containing current configuration information from a peripheral device.

In response, Applicant respectfully disagrees with the Examiner that the combination of Ohta and Furukawa disclose, teach or suggest Applicant's claimed invention. By definition, a peripheral device is not a computer, but rather something ancillary to a computer, such as a printer, scanner, or a networking device. Ohta teaches a method of configuring a computer to communicate with a peripheral device, but does not teach a method of configuring the peripheral device itself. There is nothing in the specification, drawings or claims of Ohta directed to the configuration of a peripheral device itself - the entire Ohta specification, drawings, and claims are directed to the configuration of a computer with a device driver.

The independent claims in Ohta help to illustrate this difference, for example "1. An information processing apparatus which communicates with a client device *to which a peripheral device is connected*, comprising: management means for managing installation configuration information generated when driver information for *control* of the peripheral device *is installed in a system*; and..." Notably, the peripheral is neither the information apparatus nor the client device, but is distinct from both. Also, nothing is installed in the peripheral device, but rather a

driver is installed in a client device or separate computer system for controlling the peripheral device, and therefore Ohta is not configuring or retrieving the configuration of the peripheral. The other claims read similarly: the information processing apparatus (e.g., a server) has a suitable device driver which is transmitted to the client device (e.g., a computer) and installed, thereby allowing the client device to control (e.g., print to) the peripheral device (e.g., a printer).

Also, Ohta does not disclose, teach or suggest the sending of configuration information to a peripheral device, but rather such configuration information is sent between a client and a server. This is in direct contradiction to Applicant's claimed invention wherein a host computer communicates directly with a peripheral device.

Therefore, Ohta does not teach "A method of configuring a peripheral device on a network", or "receiving a response from the peripheral device, the response including a current configuration setting of the peripheral device", or "determining by the host whether to configure the peripheral device", as claimed in independent claim 1 of Applicant's disclosure. Ohta teaches away from Applicant's claimed invention.

Also, Ohta requires a user to select on a computer screen the desired printer from the virtual printer application, and only then is the printer driver automatically installed. See Ohta, FIG. 15, and paragraph [0093]. It would be disingenuous to say that the method of Ohta is performed "without user intervention" when it requires a user to select a printer as part of the operation as described in the specification and drawings. If a user did not intervene and select a printer in Ohta then no configuration of the client, i.e., host computer, would occur at all. This is a different result than in Applicant's disclosure.

Applicant discloses and claims a system and method that allows the system to operate automatically, without requiring a user to intervene and perform some function, such as selecting. Examiner's equating of "automatically" in Ohta with Applicant's "without user intervention" would capture nearly every computer process, because after a keystroke or click of a mouse everything is done automatically by the computer. Examiner's definition would render Applicant's term "without user intervention" superfluous and meaningless for any system and method having a machine. All machines perform something automatically after a user has provided an initial impulse to the machine, and while this may be the definition of automatically it should not be read to encompass Applicant's term "without user intervention". Ohta may automatically install a device driver after a printer is selected, but it does not do so without first receiving a user's instructions via intervention.

Furthermore, one of ordinary skill in the art would not combine Ohta with Furukawa because Ohta discloses a client-server process to install printer drivers on a client (host computer), whereas Furukawa discloses an unrelated art of configuring a remote device with an IP address. For example, one of ordinary skill in the art would not install a printer driver to a peripheral, as a printer does not ordinarily require a driver to print to itself. Nor would it be particularly useful to install an IP address on a client in order to print to an unconfigured networked printer.

Therefore, Applicant respectfully contends that based on the above functional differences and requirements of both Ohta's and Furuwara's inventions, Applicant has rendered the Examiner's rejection of claim 1 moot, thereby placing Applicant's invention set forth in independent claim 1 in proper condition for allowance.

3. Claims 2-11, and 32-37 Rejection

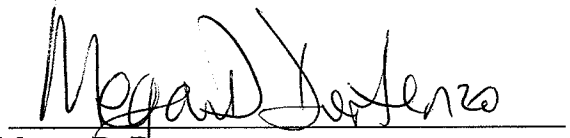
Regarding rejected dependent claims 2-11, 32-37, Applicant respectfully contends that these claims depend directly or indirectly from allowable independent claim 1. It is well established in patent law that allowance of a parent or base claim as patentable, results in allowance of a claim dependent upon that parent claim. *See* DONALD S. CHISUM, CHISUM ON PATENTS §7.04[2]. As discussed above, Applicant respectfully submits that independent claim 1 is not obvious in light of Ohta and Furukawa. Therefore, because claims 2-11, and 32-37 depend from an allowable independent claim, Applicant respectfully asserts that these claims also are in proper form for allowance. Applicant respectfully requests that Examiner withdraw his rejection and allow these dependent claims to pass to issuance.

C. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, applicant respectfully submits that all pending claims, claims 1-11 and 32-37, are in condition for allowance. If the Examiner believes, for any reason, that personal

communication will expedite prosecution of this application, the Examiner is invited to telephone or email the undersigned at the numbers provided.

Respectfully submitted,



Megan D. Dortenzo
Reg. No. 39,172

THOMPSON HINE LLP
10 West Second Street
2000 Courthouse Plaza N.E.
Dayton, OH 45402-1758
Phone: (216) 566-5579
Fax: (216) 566-5800
email: megan.dortenzo@thompsonhine.com